

Appl No 10/010,158  
Amdt dated Jun. 24, 2005  
Reply to Office action of Apr. 24, 2005

## REMARKS/ARGUMENTS

### 35 USC § 112, first paragraph

Claims 1, and 4-7 were rejected under 35 USC § 112 as failing to comply with the written description requirement. More specifically, the Examiner held that the elements "the first and second arms are each significantly wider than the bridge", "the receiving surface is curved", and "exterior surfaces extending concavely from the bridge" were not described as originally filed. The Applicant disagrees.

First, *Figure 1 clearly depicts a bag opener in which the first and second arms are each significantly wider than the bridge at least in some portion.* Nevertheless, and only to even more clearly point out the claimed subject matter, the applicant amended claim 1 to read "...first and second arms are each distally significantly wider than the bridge..." Such *limitation can unmistakably be identified in Figures 1 and 4.* If the Examiner maintains the position that Figures 1 and 4 would not disclose such feature, the applicant respectfully requests entry in the record to that effect.

Second, *groove 32 in Figures 2 and 4 unmistakably represents a curved receiving surface.* Again, if the Examiner maintains the position that Figures 2 and 4 would not disclose such feature, the applicant respectfully requests entry in the record to that effect.

Third, as amended herein, claim 1 expressly recites *outer surfaces that are concavely contoured distally for simultaneous receipt of a finger and a thumb of a user.* Literal support for such amendment is provided in the specification on numerous occasions (see e.g., page 4, line 16 et seq.) the application.

### 35 USC § 103

Claims 1, 4, and 6-7 were rejected under 35 USC § 103 as being obvious over Horning in view of Pankonin and Hanna. The applicant disagrees, especially in view of the amendments made herein.

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As amended, each of the claims expressly requires that the "...outer surfaces [of both arms]...are concavely contoured distally for simultaneous receipt of a finger and a thumb of a user..." This element is clearly neither taught nor suggested by any of the cited references. On the contrary, Homing and Pankonin teach flat arms, while the tool of Hanna has levers that are configured to receive the palm and a plurality of fingers. *The only thing the three references provide is an arguable and incomplete collection of elements found in the claims.* However, there is absolutely *no suggestion or motivation to modify/combine the references to arrive at the subject matter as presently claimed.*

Regrettably, the Office fails to offer any reasoning on the record as to why the claims were deemed obvious (see page 4 present office action, line 7 and line 14).

The office is reminded that the factual inquiry whether to combine references must be thorough and searching." *It must be based on objective evidence of record.* See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'"). The courts have held that "...teachings of references can be *combined only if there is some suggestion or incentive to do so.* (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). Indeed, *particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed* (see, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). "); Thus, the examiner can satisfy the burden of showing obviousness of the combination *"only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references* *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Claim 5 was rejected under 35 USC § 103 as being obvious over Homing in view of Pankonin and Hanna and in further view of Braatz. The applicant once more disagrees, and the

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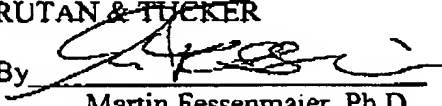
same arguments as provided above apply. Braatz fails to remedy the above listed defects.

The applicant believes that the present claim amendments are sufficient to overcome the Examiner's concerns and believes that the claims as amended are now in condition for allowance. Therefore, the applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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